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EXAMINER SHEPARD, JUSTIN E				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/786,463

**Applicant(s)**

TAYLOR ET AL.

**Examiner**

Justin E. Shepard

**Art Unit**

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

Claim 5 is objected to because of the following informalities: The preamble of claim 5 does not match the preamble of claims 1 and 4. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 6, 7, 8, 9, 12, 14, 16, 17 and 18 rejected under 35 U.S.C. 102(e) as being anticipated by Barile.

Referring to claim 1, Barile discloses an apparatus for the generation of video and/or audio by the conditional access and processing of selected portions of digital data stored on a storage medium (column 2, lines 4-16), said data stored in portions on said storage medium and said storage medium placed in processing apparatus for accessing and processing selected portions of digital data to generate video and/or audio (column 2, lines 48-54) and wherein there is provided at least one portion of data on the storage medium which is only conditionally accessible by the processing

apparatus (figure 2, part 206; column 3, lines 34-36) in response to a signal of a predesignated form transmitted from a transmitter provided as part of an actuating means (column 4, lines 7-10 and 31-34) and, said processing apparatus, upon receiving the said signal can locate the identified portion of data on the storage medium, access the same and processes the data from said portion to generate the video and/or audio (column 4, lines 7-Reference:

Referring to claim 2, Barile discloses an apparatus according to claim 1 wherein a further portion or portions of data on the storage medium are accessible in response to control signals emitted from a remote control device (column 4, lines 31-34).

Referring to claim 6, Barile discloses an apparatus according to claim 1 wherein the conditionally accessible portion of data which is accessed via the transmission of the predesignated signal is associated with the means by which the signal is generated (column 3, lines 1-3).

Referring to claim 7, Barile discloses an apparatus according to claim 1 wherein operation of one or a sequence of keys or switches on the actuating device, causes the predesignated signal to be generated and transmitted to the apparatus to allow access to the conditionally accessible portion of data on the storage medium (column 4, lines 31-34).

Referring to claim 8, Barile discloses an apparatus according to claim 7 wherein the actuating means incorporates an identified key or switch which when operated causes the predesignated signal to be transmitted (column 4, lines 31-34).

Referring to claim 9, Barile discloses an apparatus according to claim 1 wherein the predesignated signal is held in a memory in the actuation means and is transmitted continuously, at intervals, or upon operation of a control means (column 3, lines 1-3; column 4, lines 31-34).

Referring to claim 12, Barile discloses an apparatus according to claim 1 wherein the actuating means is only capable of transmitting the predesignated signal (column 4, lines 31-34).

Referring to claim 14, Barile discloses an apparatus according to claim 1 wherein once the signal has been transmitted and received by the processing apparatus, the conditionally accessible portion of data on said storage medium linked to said signal is accessed and video and/or audio from said data is displayed via a display screen and/or speakers connected to the processing apparatus (figure 1).

Referring to claim 16, Barile discloses an apparatus according to claim 1 wherein the number of times which the conditionally accessible portion of data can be accessed is limited with respect to a predesignated value (column 4, lines 40-42).

Referring to claim 17, Barile discloses an apparatus according to claim 1 wherein the actuating means is or is provided as part of a toy, model figure or soft toy (column 4, lines 25-28).

Referring to claim 18, Barile discloses an apparatus according to claim 17 wherein the predesignated signal is emitted in response to a change in condition or position of the toy (column 4, lines 31-34).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 5, 19, 20, 21, 22, 23, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barile in view of Tanaka.

Referring to claim 3, Barile does not disclose an apparatus according to claim 2 wherein the said further portions of data are accessible using the remote control device and the conditionally accessible portion of data can be accessed using actuating means other than the remote control device.

In an analogous art, Tanaka teaches an apparatus according to claim 2 wherein the said further portions of data are accessible using the remote control device and the

conditionally accessible portion of data can be accessed using actuating means other than the remote control device (figures 17 and 22; column 3, lines 51-57).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the conditional access portion of the DVD taught by Tanaka to the apparatus taught by Barile. The motivation would have been to allow for general and protected content so that the DVD would be more usable.

Referring to claim 4, Barile does not disclose an apparatus according to claim 2 wherein the said further portions Of data are accessible using the remote control device in 'conjunction with a series of options displayed on a display screen and said conditionally accessible portion of data is accessed using the signal of the predesignated format provided from the remote control device which also acts as the actuating means.

In an analogous art, Tanaka teaches an apparatus according to claim 2 wherein the said further portions Of data are accessible using the remote control device in 'conjunction with a series of options displayed on a display screen and said conditionally accessible portion of data is accessed using the signal of the predesignated format provided from the remote control device which also acts as the actuating means (figures 17 and 22; column 3, lines 51-57).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the conditional access portion of the DVD taught by Tanaka to the

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apparatus taught by Barile. The motivation would have been to allow for general and protected content so that the DVD would be more usable.

Referring to claim 5, Barile does not disclose a system according to claim 4 wherein the conditionally accessible portion of data is not indicated on screen as being accessible until the signal of a predesignated format is generated.

In an analogous art, Tanaka teaches a system according to claim 4 wherein the conditionally accessible portion of data is not indicated on screen as being accessible until the signal of a predesignated format is generated (figures 17 and 22; column 3, lines 51-57).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the conditional access portion of the DVD taught by Tanaka to the apparatus taught by Barile. The motivation would have been to allow for general and protected content so that the DVD would be more usable.

Referring to claim 19, Barile does not disclose an apparatus according to claim 1 wherein the actuating means can emit a series of predesignated signals, the selection of which signal is emitted dependant on the condition of the actuating means at any given instant.

In an analogous art, Tanaka teaches an apparatus according to claim 1 wherein the actuating means can emit a series of predesignated signals, the selection of which



signal is emitted dependant on the condition of the actuating means at any given instant (figures 17 and 22; column 3, lines 51-57).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the conditional access portion of the DVD taught by Tanaka to the apparatus taught by Barile. The motivation would have been to allow for general and protected content so that the DVD would be more usable.

Referring to claim 20, Barile does not disclose an apparatus according to claim 18 wherein each predesignated signal is linked to a particular conditionally accessible portion of data on the storage medium and allows access and processing of the same when that signal is received.

In an analogous art, Tanaka teaches an apparatus according to claim 18 wherein each predesignated signal is linked to a particular conditionally accessible portion of data on the storage medium and allows access and processing of the same when that signal is received (figures 17 and 22; column 3, lines 51-57).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the conditional access portion of the DVD taught by Tanaka to the apparatus taught by Barile. The motivation would have been to allow for general and protected content so that the DVD would be more usable.

Referring to claim 21, Barile does not disclose an apparatus according to claim 1 wherein the storage medium includes a plurality of conditionally accessible portions of

data each of which is only accessible upon receipt of an allocated predesignated signal from the actuating means.

In an analogous art, Tanaka teaches an apparatus according to claim 1 wherein the storage medium includes a plurality of conditionally accessible portions of data each of which is only accessible upon receipt of an allocated predesignated signal from the actuating means (figures 17 and 22; column 3, lines 51-57).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the conditional access portion of the DVD taught by Tanaka to the apparatus taught by Barile. The motivation would have been to allow for general and protected content so that the DVD would be more usable.

Referring to claim 22, Barile discloses an apparatus for the generation of video and/or audio by the conditional access and processing of selected portions of digital data stored on a storage medium (figures 1 and 2), said data stored in portions on said storage medium and said storage medium placed in processing apparatus for accessing and processing selected portions of digital data to generate video and/or audio and a second group including at least one portion of data which is only conditionally accessible (column 3, lines 1-3 and 34-36), said conditional access achieved when the said processing apparatus receives a predesignated signal from an actuating means (column 4, lines 7-10 and 25-28).

Barile does not disclose an apparatus wherein the storage medium includes a first group of portions of data, said portions accessible in response to signals emitted from a user selection means.

In an analogous art, Tanaka teaches an apparatus wherein the storage medium includes a first group of portions of data, said portions accessible in response to signals emitted from a user selection means (figures 17 and 22; column 3, lines 51-57).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the conditional access portion of the DVD taught by Tanaka to the apparatus taught by Barile. The motivation would have been to allow for general and protected content so that the DVD would be more usable.

Referring to claim 23, Barile does not disclose an apparatus according to claim 22 wherein the user selection means is a remote control device via which the user can select portions of data.

In an analogous art, Tanaka teaches an apparatus according to claim 22 wherein the user selection means is a remote control device via which the user can select portions of data (figures 17 and 22; column 3, lines 51-57).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the conditional access portion of the DVD taught by Tanaka to the apparatus taught by Barile. The motivation would have been to allow for general and protected content so that the DVD would be more usable.

Referring to claim 24, Barile does not disclose an apparatus according to claim 23 wherein the user selection means is used to navigate through and select options which are displayed on a display screen connected to the processing apparatus.

In an analogous art, Tanaka teaches an apparatus according to claim 23 wherein the user selection means is used to navigate through and select options which are displayed on a display screen connected to the processing apparatus (figures 17 and 22; column 3, lines 51-57).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the conditional access portion of the DVD taught by Tanaka to the apparatus taught by Barile. The motivation would have been to allow for general and protected content so that the DVD would be more usable.

Referring to claim 25, Barile discloses an apparatus according to claim 22 wherein the storage medium is a DVD, and the processing apparatus is a DVD player (column 2, lines 4-16).

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barile in view of Kamieniecki.

Referring to claim 10, Barile does not disclose an apparatus according to claim 9 wherein the signal is transmitted when the actuating means is switched on and the transmitter of the actuation means has a given signal transmission range and when the

actuating means is brought within range of the signal receiver at the processing apparatus, the conditionally accessible portion of data is accessed.

In an analogous art, Kamieniecki teaches an apparatus according to claim 9 wherein the signal is transmitted when the actuating means is switched on and the transmitter of the actuation means has a given signal transmission range and when the actuating means is brought within range of the signal receiver at the processing apparatus, the conditionally accessible portion of data is accessed (paragraph 38; Note: IR communication has a built in range as there is only so long light can travel without being interfered with).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the IR remote control signals taught by Kamieniecki to the apparatus disclosed by Barile. The motivation would have been that IR is a common type of wireless communication that is cheap and easy to implement.

Referring to claim 11, Barile does not disclose an apparatus according to claim 1 wherein the predesignated signal is transmitted by any of radio frequency, passive resistance, infrared, barcode or other data transfer system.

In an analogous art, Kamieniecki teaches an apparatus according to claim 1 wherein the predesignated signal is transmitted by any of radio frequency, passive resistance, infrared, barcode or other data transfer system (paragraph 38).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the IR remote control signals taught by Kamieniecki to the apparatus

disclosed by Barile. The motivation would have been that IR is a common type of wireless communication that is cheap and easy to implement.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barile in view of Nickum in view of Boudreau.

Referring to claim 13, Barile does not disclose an apparatus according to claim 1 wherein the actuation means is a voice actuation system and the signal of a predesignated form is a word, letter(s) or numeral(s) generated by the actuation means and received by voice signal reception means provided as part of the processing apparatus.

In an analogous art, Nickum teaches an apparatus according to claim 1 wherein the signal of a predesignated form is a word, letter(s) or numeral(s) generated by the actuation means and received by voice signal reception means provided as part of the processing apparatus (column 5, lines 54-66).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the voice command taught by Nickum to the apparatus disclosed by Barile. The motivation would have been to enable the device to work in bright areas where IR is less likely to work.

Barile and Nickum do not disclose an apparatus wherein the actuation means is a voice actuation system.

In an analogous art, Boudreau teaches an apparatus wherein the actuation means is a voice actuation system (paragraph 26).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the speaking doll taught by Boudreau to the apparatus disclosed by Barile and Nickum. The motivation would have been to allow the device to be used by Children not yet able to speak.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barile in view of Arling.

Referring to claim 15, Barile does not disclose an apparatus according to claim 1 wherein the predesignated signal comprises a selected number of data bits, the selection determined by the security level required for the signal.

In an analogous art, Arling teaches an apparatus according to claim 1 wherein the predesignated signal comprises a selected number of data bits, the selection determined by the security level required for the signal (column 5, lines 5-19).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the security to the IR signals taught by Arling to the apparatus disclosed by Barile. The motivation would have been to restrict the devices being able to control the DVD players.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/  
Supervisory Patent Examiner, Art  
Unit 2623

JS